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| 10/783,977      | 02/20/2004  | Gregory J. Speicher  | 935-016             | 4391             |

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EXAMINER

CHAMPAGNE, DONALD

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3622

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/783,977

Applicant(s)

SPEICHER, GREGORY J.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10 Nov 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7, 12, 17 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The last line of each claim recites the limitation "said text message". There is insufficient antecedent basis for this limitation in the claims.

### ***Double Patenting***

3. The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 3, 4, 6-9, 11-14, 16-19, 21 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. patent 5,996,006.
5. Independent claim 13 is claim 7 in the '006 patent, where "storing an audio recording" reads on voicemail. Claim 13 also has new limitations to "first" and "second" parties. It would

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have been obvious to one of ordinary skill in the art, at the time of the invention, that said "electronic advertisement system" reads on a personals/classified ad system, for which said two parties are obvious. It also would have been obvious to limit the taught "notification is done via the Internet" to email notification, because email is the most common and easiest means of notification done via the Internet.

6. Independent claim 3 replaces the audio recording of claim 13 with a video recording. Claim 3 is similarly constructed with claim 56 in the '006 patent in place of claim 7 of the '006 patent. Independent claim 8 adds a limitation to review and approval of said video recording prior to permitting it's viewing. This would have been obvious to prevent pornographic or other distasteful material from being shown. Independent claim 18 is a combination of independent claims 8 and 13.
7. For dependent claims 4, 6, 9, 11, 14, 16, 19 and 21, a video recording reads on a photograph.
8. Dependent claims 7, 12, 17 and 22 add a limitation to "retrieving said text message via a telephone"; the limitation "playing said text advertisement via a telephone", in claim 18 of the '006 patent, reads on that.
9. Claims 5, 10, 15 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. patent 5,996,006 in view of claim 131 (as filed on 31 January 2005) of copending Application No. 09060599. Instant claims 5, 10, 15 and 20 add to their parent claims the limitation of executing a search that finds one or more stored profiles similar to the personal profile. Because the purpose of said advertising system is to find matches, it would have been obvious to add the teachings of the '599 application to those of the '006 patent.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-22 are rejected under 35 U.S.C. 103(a) as being anticipated by Witek et al. (US006253188B1) in view of Irribarren (US005737395A) and Lubachevsky (US005764732A).
12. Witek et al. teaches (independent claims 3, 8, 13 and 18) a method for operating a computer based advertising system, wherein said method comprises the steps of: receiving from an advertiser/first party data via the Internet for a personals ad (col. 55 lines 59-60 and col. 12 lines 28-31), which inherently contains personal information that reads on a "personal profile"; a respondent/second party leaving a voicemail message for said first party via a telephone and said first party retrieving said voicemail message via a telephone (col. 2 lines 26-30). Witek et al. also teaches receiving the Internet address to which search results are to be sent (col. 21 lines 13-17 and col. 27 line 7), which reads on receiving an email address from said advertiser/first party.
13. Witek et al. does not teach that said advertiser/first party adds a video recording to said personal profile. Witek et al. does teach adding a photo (col. 45 line 62). Irribarren teaches an integrated voice and text message system where audio and video recordings can be added (col. 4 lines 53-60 and col. 15 line 654 to col. 16 line 2). Because personal ads would be more effective when animated with video, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Irribarren to those of Witek et al.
14. Witek et al. does not teach sending an email to said first party that provides notification of a voicemail message for said first party. Lubachevsky teaches sending an email to a called party/first party, that provides notification of a voicemail message for said called/first party (col. 3 lines 19-24). Because Lubachevsky teaches that this enables the calling party to get verification that the message has been received (col. 1 lines 45-50), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Lubachevsky to those of Witek et al. and Irribarren.
15. None of the references teach (independent claim 8) reviewing and approving said video before permitting others to view it. Because this would prevent pornographic or other distasteful material from being shown, it would have been obvious to one of ordinary skill in

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**DONALD L. CHAMPAGNE**  
**PRIMARY EXAMINER**

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Primary Examiner  
Art Unit 3622

30 October 2005